

**REMARKS/ARGUMENTS**

In response to the Office Action dated September 30, 2003, claims 1-8 are amended. Claims 1-8 are now active in this application. No new matter has been added.

The indication that claims 2-7 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims is acknowledged and appreciated.

**REJECTION OF CLAIMS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

Claims 1-8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In support of this position, the Examiner identifies the phrase “the starting torque” in claims 1 and 8 as lacking clear antecedent support. By this response, each of the noted points of indefiniteness has been appropriately addressed. Specifically, the non-sequiturs are eliminated. In addition, the last portion of claims 1 and 8 are amended also to change “...for starting...” to “...for **vehicle** starting...” In view of the amendments to claims 1 and 1, it is respectfully urged that the rejection be withdrawn.

**REJECTION OF CLAIMS UNDER 35 U.S.C. § 102 AND § 103**

Claims 1 and 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Yamaguchi et al. (JP 8-232817).

The rejections are respectfully traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention such that the identically claimed invention is placed into possession of one having ordinary skill in the art. *Helifix Ltd. v.*

*Blok-Lok, Ltd.*, 208 F.3d 1339, 200 U.S. App. LEXIS 6300, 54 USPQ2d 1299 (Fed. Cir. 2000);  
*Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017  
(Fed. Cir. 1994).

When a vehicle starts from a engine stop state or the engine idling state, the vehicle starting torque is different because of the difference of the real air volume aspirated by the engine in both states. More specifically, the real air volume aspirated from the engine stop state is larger than the real air amount aspirated from the engine idle rotation state for the same accelerator depression amount. A vacuum of the intake passage when the engine stops is smaller than when the engine is in the engine idle rotation state, and then real intake air amount into the cylinder is increased for an engine starting from the stopped state. Accordingly, for a common amount of accelerator pedal depression, when an operator of the vehicle starts the vehicle from the stationary state by depressing the accelerator pedal (the engine starts from engine stopped state), the engine torque is larger than when the engine is in the engine idle running state.

The present invention compensates the torque difference for a vehicle starting from these two states by absorbing starting torque by the motor/generator when the vehicle starts from the engine stopped state. More specifically, the motor/generator functions as a generator to absorb torque when the vehicle starts from the engine stopped state so that both starting torques become equal. The motor/generator does **NOT** absorb the starting torque when the vehicle starts from engine idle rotation state.

Independent claim 1 recites, *inter alia*:

control absorption of torque by the motor/generator so that *a starting torque according to the accelerator pedal depression after restart, is effectively*

*the same torque for vehicle starting from the engine stop state as for vehicle starting from the engine idle rotation state.* (Emphasis Added)

Independent claim 8 has a similar limitation.

Yamaguchi at al. (JP 8-232817) does not disclose the above described technique of absorbing torque when the vehicle starts from the engine stopped state of the present invention. What Yamaguchi at al. discloses, is that when a vehicle starts, a drive motor 4 drives the vehicle and when the vehicle speed reaches a certain speed, or at the same time with starting, a motor/generator 3 starts an engine. When the engine starts, a torque generated by the engine is suddenly **added** to the driving torque of the drive motor 4, which appears as a shock to the vehicle driving forth. To absorb this shock in Yamaguchi at al., the drive motor 4 reduces output torque of the motor at engine starting. The absorbing torque by the drive motor 4 is equal to the engine torque generated, and the drive motor 4 *always reduces the output torque whenever the engine starts.*

In contrast, in the present invention, the motor/generator only absorbs starting torque when the engine starts from the stopped state at the time the vehicle starts from stationary, and the absorbing torque is equal to a torque difference between the engine starting from stopped state and from engine idle rotation state; not to the engine torque generated itself whenever the engine starts, as disclosed in Yamaguchi at al.

The above argued difference between the claimed system vis-à-vis the system of Yamaguchi et al. undermines the factual determination that Yamaguchi et al. identically describes the claimed inventions within the meaning of 35 U.S.C. § 102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81

09/980,162

(Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1 and 8 under 35 U.S.C. § 102 for lack of novelty as evidenced by Yamaguchi et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

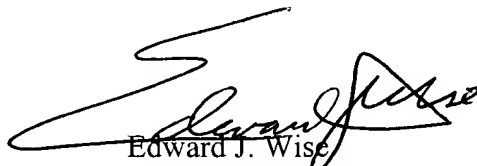
### CONCLUSION

Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY



Edward J. Wise  
Registration No. 34,523

600 13th Street, NW  
Washington, DC 20005-3096  
(202) 756-8000 EJW/dmd  
**DATE: December 30, 2003**  
Facsimile: (202) 756-8087